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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/824,463	04/15/2004	Jean-Michel Challe	P25036	6207

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EXAMINER

MOHANDESI, JILA M

ART UNIT	PAPER NUMBER
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3728

DATE MAILED: 06/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/824,463	CHALLE, JEAN-MICHEL	
	Examiner	Art Unit	
	Jila M. Mohandesi	3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>04-15-04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities: on page 4, paragraph [0021], line 3, "the upper edge of the upper" should be - - the upper edge of the liner - -.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

3. Claims 1-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 1, the phrase "both longitudinal and vertical seams being the only seams for assembling the upper to the bottom assembly" is misleading, vague and indefinite. The longitudinal and vertical seams are the only seams attaching the upper portion/vamp (41) of the liner to the bottom portion (42) of the liner and not attaching the upper (30) to the bottom assembly (10). For the purposes of the examination the examiner will treat the upper and the bottom assembly to be the upper portion and bottom portion of the liner. In claims 3-11, upper will be construed as being the liner (40).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 1-2 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Abel (3,289,328) in view of Caplan (2,003,105). Abel discloses a foot cover/liner (5) assembled along a first longitudinal assembly seam (18) and a second substantially vertical assembly seam (17), both longitudinal and substantially vertical seams being arranged on a lateral side of the shoe (see column 2, lines 1-8) and being the only seams for assembling the upper portion of the liner (7) to the bottom portion of the liner (6). See figures 1-4 embodiments and column 1, lines 31-37. This foot cover/liner is worn on a users foot before inserting the foot inside an article of footwear, which inherently will comprise an upper and a bottom assembly.

It appears that the seam (15) of Abel, which secures the edges of the upper portion together, is slightly slanted and not completely vertical. However Caplan discloses that it is desirable to connect the edges of the liner with a vertical seam. Accordingly, the skilled artisan would have been motivated to substitute the slanted seam for a vertical seam insofar as they are art-equivalents.

With respect to claim 2, Abel discloses that it is well known in the art to provide heel stiffener arranged on an exterior of said foot cover/liner. See column 1, lines 20-27

With respect to claim 5, the liner is made of terry stretch cloth, which is extensible and ventilated.

7. Claims 1-5 and 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Delgorgue et al. (US 2002/0139008) in view of Abel (3,289,328) and Caplan (2,003,105). Delgorgue discloses an article of footwear with a liner (upper 11) and two tightening quarters (lateral flaps 22) which are arranged on the medial and lateral sides of the liner, respectively, each of the tightening quarters being attached at a lower end to the liner in an area of the bottom assembly of the liner, and each of the tightening quarters is provided at an upper end with lacing guides (keepers 23). See Figure 1 embodiment. Delgorgue does not appear to teach the liner having longitudinal and vertical seams that are the only seams attaching the upper portion of the liner to the bottom portion of the liner. Abel discloses a foot cover/liner (5) assembled along a first longitudinal assembly seam (18) and a second substantially vertical assembly seam (17), both longitudinal and substantially vertical seams being arranged on a lateral side of the shoe (see column 2, lines 1-8) and being the only seams for assembling the upper portion of the liner (7) to the bottom portion of the liner (6). See figures 1-4 embodiments and column 1, lines 31-37. It appears that the seam (15) of Abel, which secures the edges of the upper portion together, is slightly slanted and not completely vertical. However Caplan discloses that it is desirable to connect the edges of the liner

with a vertical seam. Accordingly, the skilled artisan would have been motivated to substitute the slanted seam for a vertical seam insofar as they are art-equivalents.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute the liner of Delgorgue with the liner of Abel-Caplan to make the liner more comfortable and a liner which can be economically manufactured from one-piece of blank.

With respect to claim 2, Delgorgue discloses a heel stiffener (13). With respect to the location of the stiffener, it has been held that rearranging parts of an invention involves only routine skill in the art. In re Japikse, 86 USPQ 70.

With respect to claim 5, Abel discloses the liner to be made of terry stretch cloth, which is extensible and ventilated.

With respect to claim 3, Delgorgue discloses an outer gusset in the heel area of the liner (the rear portion 21 of reinforcement 20 which is thicker than the rest of the reinforcement 20 to ensure good nesting and a good retention/protection of the heel) adapted to receive a heel stiffener (13). See Figure 1 embodiment.

With respect to claim 4, official notice is taken that it is old and conventional to provide a foam housed within the outer gusset heel area to provide more comfort to the wearer. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made in view of the official notice to provide a foam within the gusseted heel area of Delgorgue to make the footwear more comfortable for the wearer.

With respect to claim 11, official notice is taken that it is old and conventional to provide a shock absorbing sole between the liner and a bottom assembly to make the

article of footwear more comfortable for the user. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made in view of the official notice to provide a shock absorbing sole to the footwear of Delgorgue to make the footwear more comfortable for the user.

8. Claims 6-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over the above references as applied to claims 1-5 above, and further in view of Johnson (D470, 647). Delgorgue as modified above discloses all the limitations of the claims except for a the liner being covered by an outer mesh protective layer. Johnson discloses an outer mesh protective layer for shielding shoes from scratches and abrasions. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide an outer mesh protective layer to the article of footwear of Delgorgue as taught by Johnson for shielding shoes from scratches and abrasions.

Conclusion

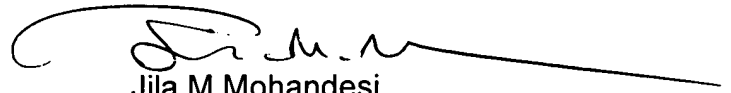
9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Shown are article of footwear analogous to applicant's instant invention.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jila M. Mohandesi whose telephone number is (571) 272-4558. The examiner can normally be reached on Monday-Friday 7:30-4:00 (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (571) 272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Jila M Mohandesi
Primary Examiner
Art Unit 3728

JMM
June 21, 2006